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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,874	09/12/2001	Irwin Jerold Singer	17037A	8268

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KIMBERLY-CLARK WORLDWIDE, INC.  
401 NORTH LAKE STREET  
NEENAH, WI 54956

EXAMINER
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SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/954,874

Applicant(s)

SINGER ET AL.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendment and accompanying remarks filed 04/05/04 have been fully considered and entered. Claim 17 has been amended as requested. Presently, claims 17-45 are under examination. Applicant's amendment to claim 17 is found sufficient to overcome the 35 U.S.C. 112, second paragraph rejection set forth in section 4 of the last Office Action. Specifically, Applicant amended claim 17 to recite a non-woven web comprising multi-component thermoplastic filaments, which sufficiently defines the structure of the second non-woven web. As such, this indefinite rejection is hereby withdrawn. Applicant's amendments however, are not found sufficient to patently distinguish the claims over the prior art of record and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

***Claim Rejections - 35 USC § 102/103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 17-20 stand rejected under 35 U.S.C. 102(e) as anticipated by McDevitt et al., US 2003/0050589 as set forth in section 6 of the last Office Action.

Applicant amended claim 17 to recite a non-woven web comprising multi-component thermoplastic filaments. Applicant argues that the instant invention is directed to a storage sleeve rather than disposable finger sleeve. As such, the Applicant asserts that McDevitt et al., does not anticipate the instant claims. This argument is not found persuasive on the grounds that it is the position of the Examiner that the intended use of a storage sleeve is not germane to the structure of the McDevitt et al., product. The Examiner asserts that since McDevitt et al., teaches the structural and chemical limitation

Art Unit: 1771

of the instant invention, the finger sleeve could function as intended by the Applicant.

With regard to the inherency of the claimed Gurley stiffness property as set forth in claims 17 and 18, the Examiner maintains that said properties are inherent to the invention of McDevitt et al. Applicant has not evidenced that said properties are not inherent to McDevitt et al. Support for said presumption is found in the use of like materials (i.e., non-woven webs of bicomponent filaments and polyethylene), which would result in the claimed property.

Thus, since McDevitt et al., meets each and every chemical and structural limitation set forth in the rejected claims especially in view of the fact that the instant claims are so broadly drafted so as to encompass any interconnected multi-layer non-woven structure including the multi-layer non-woven structure taught by McDevitt et al., then it must meet the property limitations recited that depend from said claims. Where the Examiner has reason to believe a property asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, (s)he possesses the authority to require Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. *In re Swinehart*, 169 USPQ 226,229 Applicant should take this as the Office exercising its authority.

Currently, it is the position of the Examiner that it would be necessary for skilled artisan to perform an experiment with every interconnected multi-layer non-woven structure to determine infringement. The Office believes it is Applicant's duty to provide claims that are sufficiently specific so a determination of infringement can be made without undue experimentation *Ex parte Slob*, 157 USPQ 172; Bengel Labs, LTD. Vs

Art Unit: 1771

R.K. Laros Co.; 135 UPSQ 11; *In re Bridgeford*, 149 UPSQ 55; and Locklin et al., Vs. Switzer Bros, INC. 131 USPQ 294

Additionally, while the Office recognizes a material of unknown structure can be claimed by a combination of physical and chemical characteristics *Ex parte Brian* et al., 118 USPQ 242, a sufficient number of characteristics must be set forth so as to identify what was invented *Ex parte Siddiqui*, 156 USPQ 426; *Ex parte Davission*, 133 USPQ 400; *Ex parte Fox*, 128 USPQ 157. In the instant case, Applicant's sparse of number of characteristics fails to identify anything to workers in the art. The rejected claims merely represent a desired outcome rather than the setting forth the limitations or characteristics to achieve the inventive entity.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 17-45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drew, US 6,186,320 in view of Midkiff et al., US 5,709,735 as set forth in section 8 of the last Office Action.

Applicant amended claim 17 to recite a non-woven web comprising multi-component thermoplastic filaments. Applicant argues a lack of motivation to combine the references of Drew, US 6,186,320 and Midkiff et al., US 5,709,735 to form the obviousness type rejection above. Specifically, Applicant asserts that one of ordinary skill in the art would not be motivated to combine the flexible storage sleeve taught by Drew with the high stiffness non-woven material taught by Midkiff et al. This argument is not found persuasive on the grounds that though not exemplified, Midkiff et al., teaches employing the non-woven web material in a variety of applications including

Art Unit: 1771

protective fabrics and towels. As such, it is the position of the Examiner that the stiffness of the non-woven fabric is a function of the desired end use. In the instant case, Midkiff et al., happens to exemplify a high stiffness non-woven filtration material, however, it would be expected that when the non-woven material is employed as towel or a protective fabric the stiffness would vary. In addition the Examiner asserts that teaching of a flexible storage sleeve by Drew does not necessarily preclude providing a storage sleeve also having good structural integrity. Since Drew does not limit the degree of flexibility and as such it is the position of the Examiner that employing the spun-bonded polyolefin non-woven web, which comprises all of the claimed structural and chemical features set forth including the Gurley stiffness property limitation, would not necessarily render the storage sleeve of Drew inflexible. Moreover, the flexible storage sleeve of Drew must have some minimum degree of stiffness or it would lack sufficient structural integrity to function as a storage sleeve. Applicant also argues that the combination of prior art also fails to teach the bulk density range, however, the Examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the value of the bulk density as a function of intended final use. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d, 272,205 USPQ 215 (CCPA 1980)

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1771


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1482. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 15, 2004

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